

20



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/488,969	01/21/2000	William J. Baer	STL000017US1	5170

23373 7590 05/18/2004  
SUGHRUE MION, PLLC  
2100 PENNSYLVANIA AVENUE, N.W.  
SUITE 800  
WASHINGTON, DC 20037

EXAMINER

NGUYEN, MAIKHANH

ART UNIT PAPER NUMBER

2176

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/488,969

Applicant(s)

BAER ET AL.

Examiner

Maikhanh Nguyen

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 01/2004, 04/2004
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This action is responsive to communications: Amendment filed 02/12/2004 to the original application filed 01/21/2000; IDS filed 01/29/2004 and 04/13/2004.
2. Claims 1-15 are currently pending in this application. Claims 1, 6 and 11 are independent claims.
3. Please note the Article (IDS filed 04/13/2004) has not been considered since a publication date cannot be determined.

**Rejections - 35 USC § 102**

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language; or " (Emphasis added.)

Claims 1, 6, and 11 are rejected under 35 U.S.C. 102(e) as being anticipated **Prinzing** (U.S. 6,592,628 – filed 02/1999).

As to independent claim 1, Prinzing teaches a method for providing prerequisite checking in a system for creating compilations from a plurality of content objects stored in a data repository, each content object comprising a plurality of content entities, some of the content entities being prerequisites to others of the content entities (*the content of a document ... content*

Art Unit: 2176

*can be text, alphanumeric data, or any other information contained in a document ...stored in a storage area; Abstract*), comprising the steps of:

upon addition or removal of a content entity to or from the compilation, determining if the content entity has any prerequisite content entities, and if so, adding or removing the prerequisite content entities *(the manipulation of content in the storage area includes inserting content in the content entity, removing content from the content entity ...The information retrieved from the element entities is used to manipulate the content stored in the storage area associated with the content entity; col.2, lines 21-67 & col.3, lines 27-58)*.

**As to independent claim 6**, it is directed to a program storage device for implementing the method of claim 1, and is similarly rejected under the same rationale.

**As to independent claim 11**, it is directed to a system for performing the method of claim 1, and is similarly rejected under the same rationale.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-5, 7-10, and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Prinzing** in view of **Cousins et al.** (U.S. 6,351,752 – filed 07/1998).

**As to dependent claim 2**, Prinizing does not explicitly teach “one or more of the prerequisites are conditional.”

Cousins teaches one or more of the prerequisites are conditional (*col.3, lines 37-49*).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the feature from Cousins in the system of Prinizing because Cousin teaching would have provided the capability for determining whether the condition is satisfied before generating a rule based on information in an entry.

**As to dependent claim 3**, Prinizing does not explicitly teach “the conditions for applying a prerequisite are defined in one or more rules.”

Cousins teaches the conditions for applying a prerequisite are defined in one or more rules (*col.3, line 37-col.4, line 4*).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the feature from Cousins in the system of Prinizing because Cousins' teaching would have provided the capability for determining whether the condition is satisfied before generating a rule based on information in an entry.

**As to dependent claim 4**, Prinizing does not explicitly teach “in the case of more than one rules pertaining to the same prerequisite, further comprising the step of reducing the rule set if possible into a smaller set of rules.”

Cousins teaches in the case of more than one rules pertaining to the same prerequisite, further comprising the step of reducing the rule set if possible into a smaller set of rules (*col.4, lines 5-47*).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the feature from Cousins in the system of Prinzing because Cousins' teaching would have provided the capability for determining whether the condition is satisfied before generating a rule based on information in an entry.

**As to dependent claim 5**, Frinzing does not explicitly teach "the step of rewriting any negative rules as positive rules."

Cousins teaches the step of rewriting any negative rules as positive rules (*col. 4, lines 5-47*).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the feature from Cousins in the system of Prinzing because Cousins' teaching would have provided the capability for determining whether the condition is satisfied before generating a rule based on information in an entry.

**As to dependent claims 7-10 and 11-15**, they include the same limitations as in claims 2-5, and are similarly rejected under the same rationale.

### ***Response to Arguments***

6. Applicant's arguments filed 02/12/2004 have been considered but they are not persuasive.

Applicant argues: "*Prinzing does not disclose or suggest that 'some of the content entities being prerequisites to others of the content entities.'*" (Remarks, page 10). Also, "*Prinzing does not disclose or suggest 'providing prerequisite checking in a system for creating compilations*

*from a plurality of content objects stored in data repository, each content object comprising a plurality of content entities.*" (Remarks, page 11)

In response to applicant's arguments, the recitation "some of the content entities being prerequisites to others of the content entities" and "*providing prerequisite checking in a system for creating compilations from a plurality of content objects stored in data repository, each content object comprising a plurality of content entities*" have not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

### **Conclusion**


7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (703) 306-0092. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on (703) 305-9792.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Maikhanh Nguyen  
May 13, 2004

  
JOSEPH FEILD  
SUPERVISORY PATENT EXAMINER